

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ICHIRO KURAWAKI,
TOYOJI TANAKA
and KAZUMASA NAKAYA

Appeal No. 96-2475
Application 08/319,473¹

ON BRIEF

Before MEISTER, ABRAMS and NASE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed October 6, 1994. According to appellants, the application is a continuation of Application 07/989,194, filed December 11, 1992, now abandoned, which is a continuation-in-part of Application 07/786,733, filed November 1, 1991, now abandoned.

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This is an appeal from the decision of the examiner finally rejecting claims 1 and 3 through 22. Claims 2 and 23 through 27 have been canceled. No claims have been allowed.

The appellants' invention is directed to a steering and suspension arrangement for the front wheel of a motorcycle. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A steering and suspension arrangement for a front wheel of a motorcycle comprising: a frame, an engine adjoining said frame, a steering knuckle extending along one side of said front wheel, an upper swing arm having first and second ends, a first pivotal connection between said first end of said upper swing arm and said frame and a second pivotal connection between said second end of said upper swing arm [and] an upper portion of said steering knuckle, a lower swing arm having first and second ends, a third pivotal connection between said first end of said lower swing arm and said frame and a fourth pivotal connection between said second end of said lower swing arm and a lower portion of said steering knuckle; said lower swing arm being longer than said upper swing arm, along a longitudinal direction of said motorcycle, and said first pivotal connection being positioned forward of said third pivotal connection and lying on an upper line of an imaginary parallelogram, said imaginary parallelogram having four apexes with three of said apexes lying on the second, third and fourth pivotal connections, respectively, when the motorcycle is normally laden so that said swing arms function substantially as a parallelogram.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Knapp

5,044,648

Sep. 3, 1991

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Ohma (U.K. Patent Application)	2 112 877	July 27, 1983
Tanaka (Japan)	3-136996	June 11, 1991
Kurawaki et al. (Kurawaki) (Japan)	3-136994	June 11, 1991

THE REJECTIONS

Claims 1 and 2 through 15 stand rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Tanaka.

Claims 1 and 2 through 15 also stand rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Kurawaki.

Claims 16 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tanaka in view of Ohma.

Claims 16 through 20 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Kurawaki in view of Ohma.

Claims 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tanaka in view of Knapp.

Claims 21 and 22 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Kurawaki in view of Knapp.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellants are set forth in the Brief.

OPINION

The appellants have expressed the following view with regard to the examiner's rejections:

The disclosures of those published Japanese applications [Tanaka and Kurawaki] illustrate the subject matter which is claimed in Claims 1 and 3-15. This subject matter also forms the basis upon which the remaining dependent claims rely. Brief, page 3.

However, it is the appellants' position that Tanaka and Kurawaki, which were published within one year of the effective filing date of the instant application, are not proper references. We agree, noting, as explained below, that this has no bearing on claims 21 and 22, however.

The present application claims an effective filing date of November 1, 1991, on the basis of two parent applications. Both of the Japanese patent applications cited as references were published on June 11, 1991, some four months prior to the earliest application before us. The Messrs. Kurawaki and Tanaka named as the two inventors in the first publication, and the Mr. Tanaka named as the sole inventor in the second, are the inventors in the present application, along with Mr. Nakaya (Brief, page 3). As set forth in Section 715.01(c) of the Manual of Patent Examining Procedure, a rejection based on a publication

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that is not a statutory bar may be overcome by a showing that it was published either by the applicant or on his/her behalf. That is, a publication of the inventor's own work within one year prior to the filing date of the patent application cannot be used as a reference.

There is a very strong commonality in the information disclosed in the two Japanese publications, the two parent applications, and the instant application, although the inventive entities are different in the three cases. However, the inventors have made of record in the file of the present application a declaration which states:

(1) That the invention of independent claim 1 was co-invented by Kurawaki and Tanaka, who also were the source of any disclosures of such subject matter in the two Japanese references.

(2) That the invention of independent claim 14 was invented by Kurawaki, Tanaka and Nakaya, who also were the source of any disclosures of such subject matter in the two Japanese references.

The three inventors thus are attesting to the fact that, notwithstanding the name(s) that appear on each of the two references, they were the source of the information contained therein which pertains to the inventions of claims 1 and 14 of the present application. It is our opinion that this declaration

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constitutes evidence which compels the removal of the two Japanese publications as references against these two claims on the basis that the pertinent information set forth therein was the applicants' own work. In this regard, it should be recognized that the those named as the inventors of the invention for which the patent protection is sought in an application may not necessarily be those who are responsible for all of the information contained in the disclosure.

The subject matter presented in claims 1 and 3 through 20 was present in each of the two parent applications, and

therefore has an effective filing date of November 1, 1991. The Japanese publications are not effective references as to these claims, for the reasons discussed immediately above, and we therefore will not sustain the rejections of such.

A different conclusion arises, however, with regard to claims 21 and 22. The subject matter added by dependent claims 21 and 22 was not present in the earliest application, as was the case with all of the other claims, but was added in the continuation-in-part application filed on December 11, 1992. In such a situation, that some subject matter in a claim may have the support of an earlier application than other of the subject

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matter does not alter the fact that as to a given claim, only one effective date is applicable, and that date is based upon when the totality of the subject matter met the requirements of 35 U.S.C. § 120. See *In re van Langenhoven*, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972). Therefore, the effective filing date of claims 21 and 22 is December 11, 1992. This date is more than one year after the publication of the two Japanese references, and therefore the declaration provided by the appellants does not disqualify them as references.

Claims 21 and 22 stand rejected as being unpatentable over either of the Japanese publications, each taken in view of Knapp.

Aside from their contention that the Japanese publications are not proper references against any of the claims, which is not applicable to claims 21 and 22 for reasons explained above, the appellants have not presented arguments that the teachings of these two combinations of references fail to render the subject matter of the two claims unpatentable. The examiner's position therefore going unchallenged, we shall sustain these two rejections.

Summary:

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The rejection of claims 1 and 2 through 15 as being clearly anticipated by Tanaka is not sustained.

The rejection of claims 1 and 2 through 15 as being clearly anticipated by Kurawaki is not sustained.

The rejection of claims 16 through 20 as being unpatentable over Tanaka in view of Ohma is not sustained.

The rejection of claims 16 through 20 as being unpatentable over Kurawaki in view of Ohma is not sustained.

The rejection of claims 21 and 22 as being unpatentable over Tanaka in view of Knapp is sustained.

The rejection of claims 21 and 22 as being unpatentable over Kurawaki in view of Knapp is sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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